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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/071,664 05/01/98 SHAFFER

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EXAMINER

LM01/0518

SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
186 WOOD AVENUE SOUTH
ISELIN NJ 08830

FILED

ART UNIT

PAPER NUMBER

2742

DATE MAILED:

05/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/071,664

Applicant(s)

Shaffer et al

Examiner

Bing Bul

Group Art Unit

2742

☒ Responsive to communication(s) filed on Mar 20, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-19 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2742

DETAILED ACTION

1. This action is in response to applicant's response filed on Mar 20, 2000. Claims 1-19 are now pending in the present application. **This action is made final.**

Claim Rejections - 35 U.S.C. § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-4, 6, 10-14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chakravarti et al (US Pat No. 5,987,112) in view of Wu (US Pat No. 6,031,899).

Art Unit: 2742

Regarding claim 1, Chakravarti et al teach the invention substantially as claimed, a method for providing an automated call connection system comprising the steps of:

initiating a call back request from a first user to a second user (Fig 1 and col 2, ln 22-col 3, ln 45);

sending the call back request from the first user to the second user (Fig 1 and col 2, ln 22-col 3, ln 45);

receiving the call back request (Fig 1 and col 2, ln 22-col 3, ln 45);

immediately and automatically attempting to connect the first user (Fig 1 and col 2, ln 22-col 3, ln 45).

Chakravarti et al differ from claimed invention in that it does not clearly point out the second user's choice of whether or not to accept a call back request.

However, Wu teaches the caller ID associated with the call displayed at second user terminal such that the second user can decide whether or not to take the call (col 1, ln 48-56).

Therefore, it would have been obvious to one skilled in the art to add the caller ID feature associated with the call displayed at second user terminal as taught by Wu to network of Chakravarti et al to achieve Applicant's claimed limitations.

Regarding claim 2, Chakravarti et al teach the invention substantially as claimed, a method for providing an automated call connection system further comprising the step of using a separate packet-based network to determine if the second user is ready to accept the call back request (Fig 1 and col 2, ln 22-col 3, ln 45).

Art Unit: 2742

Regarding claim 3, Chakravarti et al teach the invention substantially as claimed, a method for providing an automated call connection system further comprising the step of bypassing call toll charges by using a packet-based network for the sending of call back requests (Fig 1 and col 2, ln 22-col 3, ln 45).

Regarding claim 4, Chakravarti et al teach the invention substantially as claimed, a method for providing an automated call connection system further comprising the step of utilizing a computer for the sending of the call back requests to a server collecting the call back requests for immediate delivery to the second user (Fig 1 and col 2, ln 22-col 3, ln 45).

Claims 6, 11 and 17 are rejected for the same reasons as recited in the rejection of claim 1.

Regarding claim 10, Chakravarti et al teach the invention substantially as claimed, wherein a personal digital assistant is used to initiate the call back request (Fig 1 and col 2, ln 22-col 3, ln 45).

Claim 12 is rejected for the same reasons as recited in the rejection of claim 2.

Claim 13 is rejected for the same reasons as recited in the rejection of claim 3.

Claim 14 is rejected for the same reasons as recited in the rejection of claim 4

4. **Claims 5, 7, 9, 15-16 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chakravarti et al in view of Wu, and further in view of Svennesson et al (US Pat No. 6,005,845).

Art Unit: 2742

Regarding claim 5, the combination of Chakravarti et al and Wu teach the invention substantially as claimed with the exception of lacking to disclose the call back requests are automatically sent via at least one of an E-mail message, a page and a facsimile.

However, Svennesson et al disclose the call back requests are automatically sent via at least one of an E-mail message, a page and a facsimile (col 6, ln 1-14).

Therefore, it would have been obvious to one skilled in the art to add the sending method respected to call back requests via at least one of an E-mail message, a page and a facsimile as taught by Svennesson et al to integration network of Chakravarti et al and Wu to achieve Applicant's claimed limitations.

Claims 7, 9, 15-16 and 18 are rejected for the same reasons as recited in the rejection of claim 5.

5. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chakravarti et al in view of Wu, and further in view of Silverman (US Pat No. 6,035,031).

Regarding claims 8 and 19, the combination of Chakravarti et al and Wu teach the invention substantially as claimed with the exception of lacking to disclose the method of:

maintaining a connection between the first user and the second user for a predetermined period of time;

wherein the predetermined period of time is specified by the first user.

However, Silverman discloses the invention substantially as claimed, the method of:

Art Unit: 2742

maintaining a connection between the first user and the second user for a predetermined period of time (col 3, ln 31-41);

wherein the predetermined period of time is specified by the first user (col 3, ln 31-41).

Therefore, it would have been obvious to one skilled in the art to add the method and system for maintaining connection between the first and second users corresponding to a period of time specified by first user as taught by Silverman to integration network of Chakravarti et al and Wu to achieve Applicant's claimed limitations.

Response to Arguments

6. Applicant's arguments filed on Mar 20, 2000 have been fully considered but they are not persuasive.

In response to Applicant's argument that Smiley does not include the limitation that upon acceptance of the call-back request, connection is immediately attempted. Examiner agrees with this Applicant's point of view. However, rejection is still sustained with new ground of rejection provided by Examiner in this Office Action.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2742

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sheinbein (US Pat No. 4,166,929) discloses an interoffice callback arrangement.

Martinez (US Pat No. 5,784,438) discloses an automatic callback system and method.

8. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

Art Unit: 2742

(703) 308-6306, for formal communications intended for entry (please label the response "EXPEDITED PROCEDURE")

or:

(703) 308-6296, for informal or draft communications not intended for entry (please label the response "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bing Bui whose telephone number is (703) 308-5858. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Krista Zele, can be reached on (703) 305-4701.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Bing Bui

Patent Examiner

May 12, 2000



KRISTA ZELE
SUPERVISORY PATENT EXAMINER
GROUP 2700